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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,105	07/08/2003	Isao Yamazaki	KAS-187	7653

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MATTINGLY, STANGER & MALUR, P.C.
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EXAMINER

TURK, NEIL N

ART UNIT	PAPER NUMBER
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1743

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 10/614,105	Applicant(s) YAMAZAKI ET AL.	
	Examiner Neil Turk	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 26 December 2006.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-5 and 7-9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-5 and 7-9 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>5/26/04, 7/8/03, 12/27/06</u> .	6) <input type="checkbox"/> Other: _____

U.S. Patent and Trademark Office
PTOL-326 (Rev. 08-06)

Office Action Summary

Part of Paper No./Mail Date 20070326

DETAILED ACTION

Remarks

This Office Action fully acknowledges Applicant's remarks filed on December 26th, 2006. Claims 1-5 and 7-9 are pending. Claims 6 and 10-12 have been cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The recitation of, "a plurality of reagent disks having respective rotation axes that are different from each other;" is unclear in that the specification states that the plural reagent disks may be arranged concentrically with their central axes extending along the same line and also states that the reagent disks can rotate independently with each other (pages 5 and 13). However, in the case that the reagent disks rotate independently with each other, the specification teaches that only one dispensing probe is utilized. The claims currently require plural dispensing probes and from the drawings

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and the specification it appears that embodiments of the invention are being mixed for which support does not exist.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umetsu (5,051,238) in view of Ginsberg (4,276,051).

Umetsu discloses an automatic analyzing system. Umetsu discloses a sample table (first reagent disk) 315, having sample vessel pockets 314 arranged at intervals around the circumference (lines 21-28, col. 3, fig. 1). Umetsu also discloses a reagent table 310 (second reagent disk) having reagent vessels 311 disposed around the circumference (lines 29-36, col. 3, fig. 1). Umetsu also discloses that the reagent table 310 has a plurality of reagent pack pockets 312a, each having receiving a reagent pack 312 which includes three reagent vessels 311, charged with different reagents (lines 35-42, col. 3, fig. 1). Umetsu further discloses a reaction table 302 having a plurality of reaction vessel pockets 301 arranged in the circumferential direction (lines 43-50, col. 3, fig. 1). Umetsu discloses that the reaction vessel pockets 301 receive reaction vessels 301' (lines 60-63, col. 3, fig. 1). Umetsu additionally discloses that a single pipetting device 317 is disposed between the reaction table 302 and the reagent table 310; the pipetting device has a pivotable arm 300 (capable of necessary movements between the respective tables) about the axis of shaft 304, and a probe 318 having liquid removing and discharging function (lines 65-67, col. 3; lines 1-12, col. 4, fig. 1). Umetsu discloses that the pipetting device is capable of moving samples from sample vessels 314' and discharging them into reaction vessels 301'; the pipetting device can also suck reagents from reagent vessels 311 and discharging them into reaction vessels 301'.

(lines 1-19, col. 4, fig. 1). Umetsu further discloses that the reaction table carries a fluorescent photometer 325; light emitted from light source 326 is applied to the successive reaction vessels and the light transmitted through the reaction vessels is measured by the fluorescent photometer 325 (or light absorbing photometer), to thereby analyze a sample (lines 20-27, col. 4, fig. 1). Umetsu discloses the operation and manner of use of the analyzing system in figure 1 as described above in lines 38-67 of col. 4 to line 57 of column 5.

Umetsu does not disclose a plurality of dispensing probes. Umetsu does not disclose a plurality of sets composed of a sample dispensing probe, reagent dispensing probe, and a reagent disk.

Ginsberg discloses first and second reagent dispensing arms 34 and 40 (from reagent tray 16) for dispensing a first and second reagent respectively to determined locations of cuvettes at reagent dispensing locations 18" (first reagent dispensing location) and 18"" (second reagent dispensing location) on disk (lines 59-67, col. 5; lines 1-67, col. 6, fig. 1). Ginsberg also discloses a sample dispensing arm 28 (from sample tray 14) with a probe 66 for picking up and dispensing of sample aliquots (lines 9-68, col. 4, fig. 1). Ginsberg discloses that first and second reagent dispensing arms 34, 40 and sample dispensing arm 28 are controlled in by motors for their movement to respective cuvette sites and tabs are read by a reader to determine when they are in the pick-up position (col. 4-6). Ginsberg also discloses method which involves the use of the first and second reagent dispensing arms 34, 40 and sample dispensing arm 28 in aspirating and dispensing of separate sample/reagent combinations to subsequent

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different cuvettes 18 for different reaction observations (col. 16-26, claims 1-57).

Examiner interprets the individual combinations of reagent dispensing arms 34, 40, sample dispensing arm 28, and respective reagent disk used to form separate reaction mixtures constitutes the sets as claimed in claim 4, such that multiple analyses are being created through the respective combinations.

It would have been obvious to modify the Umetsu device to include a plurality of dispensing probes such as taught by Ginsberg so as to allow the Umetsu device to more quickly dispense the multiple reagents contained in the reagent vessels to the reaction vessels. It would have been obvious to modify the Umetsu device to include sets composed a sample dispensing probe, reagent dispensing probe, and reagent disk such as taught by Ginsberg in order to provide for multiple, different reaction mixtures to be formed for analysis.

Response to Arguments

Applicant's arguments with respect to claims 1-5 and 7-9 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that Ginsberg (4,276,051) does not teach that the reagents are added into the same reaction cell at the same dispensing position. However, this is not the case in that Ginsberg discloses that the first reagent is to the cuvette at dispensing location 18" and the second reagent is delivered to the cuvette at dispensing location 18"', thereby the reagents are added to the reaction cell at the same dispensing positions such that the first reagent is always delivered in the 18" location to the cuvette and the second reagent is always delivered to the cuvette at the 18"' location. Further, both Umetsu and Ginsberg disclose probes which are both capable of removing/sucking up reagent and discharging reagent into reaction wells; see line 65 column 3 to line 12 column 4 of Umetsu for example, and columns 5-8 in Ginsberg.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not


mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Turk whose telephone number is 571-272-8914. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NT


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